

Nair shows that element 48 is actually a printed circuit board, and not a semiconductor support substrate. See Nair, Col. 8, lines 3, 6, 27, 46, etc. Since Nair does not disclose “[a]n integrated circuit with a micromechanical element comprising a semiconductor support substrate” as claimed by the Applicants, independent claim 1 (and dependent claims 2-7) should be allowable over this reference.

The assertion is also made that Nair’s element 70 is a sensor element as claimed in claim 7. However, it is respectfully noted that claim 7 includes sensor elements “selected from the group consisting of strain gauges, thermal gauges, radiation gauges, and chemically responsive gauges.” Nair describes element 70 as “screened carbon keypad electrical contacts” (see Nair, Col. 9, lines 10 and 47). Since Nair does not disclose a sensor element “selected from the group consisting of strain gauges, thermal gauges, radiation gauges, and chemically responsive gauges” as claimed by the Applicants, claim 7 should also be allowable over this reference. The Applicants therefore respectfully request reconsideration and withdrawal of this rejection under 35 USC § 102.

### §103 Rejection of the Claims

Claims 2-6 were rejected under 35 USC § 103(a) as being unpatentable over Nair in view of Ogihara et al. (US 6,222,208 B1, hereinafter “Ogihara”). Because a *prima facie* case of obviousness has not been established, the Applicants respectfully traverse this rejection.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). The M.P.E.P. contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)).

Serial Number: 09/346,283

Filing Date: July 1, 1999

Title: INTEGRATED CIRCUIT WITH UNIFIED INPUT DEVICE, MICROPROCESSOR AND DISPLAY SYSTEMS

While it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 U.S.P.Q.2d (BNA) 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 U.S.P.Q. (BNA) 171, 174 (C.C.P.A. 1979)). The requirement of a suggestion or motivation to combine references in a *prima facie* case of obviousness is emphasized in the Federal Circuit opinion, *In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002), which indicates that the motivation must be supported by evidence in the record.

First, there is no motivation to combine the references because Nair teaches away from combination with Ogihara. As noted in Nair, it is an object of the invention "to provide an improved low cost card transaction terminal". Nair, Col. 6, lines 19-20. Further, Nair recites that the cost of terminals is determined by "several major factors" including the level of functionality and the cost of parts themselves. See Nair, Col. 3, lines 8-19. Nair attempts to provide "an extremely low cost authorization terminal". See Nair, Col. 2, lines 66-68. Substituting the expensive and complicated display (e.g., having 1200 dpi resolution) of Ogihara for the inexpensive LCD display of Nair destroys the purpose of Nair's invention.

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985). References must be considered in their entirety, including parts that teach away from the claims. See § MPEP 2141.02. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed invention. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), and M.P.E.P. § 2143.01.

Second, such a combination gives no reasonable expectation of success. Ogihara expresses no need for combination with Nair, and therefore, such a combination adds nothing to satisfy the expressed needs of Ogihara. Also, as mentioned previously, substituting the

**RESPONSE UNDER 37 CFR § 1.111**

Serial Number: 09/346,283

Filing Date: July 1, 1999

Title: INTEGRATED CIRCUIT WITH UNIFIED INPUT DEVICE, MICROPROCESSOR AND DISPLAY SYSTEMS

**Page 4**

Dkt: 450.202US1

expensive display of Ogihara for the inexpensive LCD display of Nair serves to increase the cost of Nair, which is at cross-purposes with the expressed needs of Nair.

Finally, neither reference discloses a “[a]n integrated circuit with a micromechanical element comprising a semiconductor support substrate supporting a sensor element” as claimed by the Applicants in independent claim 1, and in dependent claims 2-7. Thus, a combination of Nair and Ogihara will not serve to supply this missing element.

Therefore, since there is no motivation to combine the references, since there is no reasonable expectation of success if the references are combined, and since such a combination does not teach all of the claimed elements, a *prima facie* case of obviousness has not been established and claims 2-6 should be allowable over the combination of Nair and Ogihara. Thus, the Applicants respectfully request reconsideration and withdrawal of this rejection under 35 USC § 103.

RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/346,283

Filing Date: July 1, 1999

Title: INTEGRATED CIRCUIT WITH UNIFIED INPUT DEVICE, MICROPROCESSOR AND DISPLAY SYSTEMS

Page 5

Dkt: 450.202US1

**CONCLUSION**

The Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicants' undersigned attorney (direct: 210-308-5677) to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

Respectfully submitted,

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 16<sup>th</sup> day of October, 2002.

**Candis B. Buending**

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Signature

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